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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/070,284

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Kenshu Shimada

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EXAMINER

FADOK, MARK A

ART UNIT

PAPER NUMBER

3625

MAIL DATE

DELIVERY MODE

10/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/070,284 | SHIMADA, KENSU | |
| | Examiner | Art Unit | |
| | MARK FADOK | 3625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-55 is/are pending in the application.
- 4a) Of the above claim(s) 5,7,10,13 and 15-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,8,9,11,12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/17/2008 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In this case there is no mention of the term "inventory" or "functionality".

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 6, 8, 9, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US 6,167,383) in view of Norris et al. (US 7,113,919 B1) (“Norris”) and further in view of Entwistle (US 6,782,551 B1) and Kennedy.

Referring to claim 1: Henson teaches a commodity selling apparatus for accepting an order of a commodity responsive to a request by a customer to purchase the commodity over a network and for directly shipping the ordered commodity to said customer, comprising:

- order information acquisition means for acquiring the order information, prepared on accepting the request to purchase the commodity from the customer, over the network and commodity shipping command means for commanding the shipping of the commodity ordered to said customer based on said order information acquired by said order information acquisition means (see at least Abstract, col. 1, lines 60 – 63; col. 3, lines 31 - 32 and Figures 1 , 2 and 3C);
- proposed-order determining means for determining a proposed order including a list of one or more related commodities determined to be connectable to the commodity based on related commodity information associated with the commodity (col. 9, lines 1-8; col. 9, lines 56-60; col. 10, lines 7-15). The Applicant’s specification discloses that term “related commodity” is a commodity “...that can be connected to a specified commodity by at least one of the direct connection, wireless connection, removable connection, internal mounting and indirect loading.” (see specification page 57, lines 7-10). Henson teaches recommending an add-on, upgrade, or a cross-sell based on the contents of the shopping cart. These add-

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ons and upgrades can be hardware or software that require a direct connection and/or loading.

- related commodity information transmission means for transmitting the proposed order over the network and wherein the order information acquisition means acquires the order information over the network following transmission of the proposed order by the related commodity information transmission means (Abstract and Figures 1, 2 and col. 3, lines 45 - 54);

Henson does not teach that the commodity information includes purpose information, specifying the purpose of using or purchasing the commodity. However, Norris teaches a system for configuring products over a network. Norris discloses that it is well known for a component specification (i.e. commodity information) to specify the use of the component (col. 2, lines 1-8; col. 5, lines 10-21). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Norris into the invention of Henson. One of ordinary skill in the art would have been motivated to do so in order to allow a user to better understand how the components can be used and/or combined with other components. The cited prior art does not teach attention instigation transmitting means for transmitting attention instigation information if one of the related commodities from the proposed order is determined to be unnecessarily redundant. However, Entwistle teaches a system for visually indicating to a user that a selected program was previously viewed (i.e. “attention instigation transmitting means...”) (Abstract; figure 2B, “19”). Entwistle further teaches distributing a content item to the apparatus through the communication network

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in response to a request based on the offerable content list (i.e. EPG) indicating which content items have been already owned by the user and updating the owned content list stored in the storage unit in response to the distribution of the content item to the apparatus (col. 4, lines 14-30). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Entwistle into the invention of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to keep the user database of the prior art current and up to date.

Referring to claim 3: Henson teaches a commodity selling apparatus wherein said related commodity information transmission means includes delivery term presenting means for presenting the term of delivery of the commodity and the quantity of possible orders under said term of delivery, in a confirmable form, responsive to a request from a sale store, to said sale store over said network; said order information acquisition means acquiring, from said sale store, the order information prepared on accepting the request to purchase the commodity from the customer in accordance with a delivery term presented by said delivery term presenting means, over said network; said commodity shipping command means commanding the shipping to said customer of the commodity booked on the basis of the order information acquired by said order information acquisition means, within the term of delivery presented by said delivery term presenting means (col. 7, lines 1 - 21 and Figure 9).

Referring to claim 6: Henson teaches a commodity selling apparatus wherein said order information acquisition means acquiring the information specifying a

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commodity as the order information and the information pertinent to the shipping destination of said commodity; said commodity shipping command means transmitting the information pertinent to the shipping destination of said commodity along with a command for shipping the booked community (Figure 9).

Referring to claim 8: Henson teaches a commodity selling apparatus wherein said related commodity information transmission means including delivery term presenting means for presenting the term of delivery of a commodity and the quantity of possible orders under said delivery term in a confirmable form to a booking terminal connected over a network to said related commodity information transmission means responsive to a request from said booking terminal (Figure 9);

said order information acquisition means acquiring from said booking terminal the order information formulated on the basis of the request by a customer to purchase a commodity under a term of delivery presented by said delivery term presenting means (Figure 9);

said commodity shipping command means commanding the shipping of the booked commodity to said customer within the term of delivery presented by said delivery term presenting means, based on the order information acquired by said order information acquisition means (Abstract and Figure 9).

Referring to claim 9: Henson teaches a commodity selling apparatus according wherein said commodity is formed by a plurality of individual commodities (Figure 3A); said related commodity information transmission means including delivery term presenting means for presenting, responsive to a request from a sale store, the term of

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delivery of said individual commodities and the quantity of possible orders under said delivery term in a confirmable form to said sale store (Figure 9); said order information acquisition means acquiring from said sale store the order information formulated on the basis of the request from a customer to purchase the commodity under the term of delivery presented by said delivery term presenting means (Abstract and Figure 9); said commodity shipping command means commanding the booked commodity to be shipped to said customer within the term of delivery presented by said delivery term presenting means on the basis of the order information acquired by said order information acquisition means (Figure 9).

Referring to claim 12: Henson teaches a commodity selling apparatus according wherein said order information acquisition means acquires the information specifying the individual commodity forming a commodity as the order information and the information pertinent to the shipping destination of said commodity; said commodity shipping command means transmitting the information pertinent to the shipping destination of said commodity along with a shipping command for the booked commodity (Figure 9).

Referring to claim 14: Henson teaches a commodity selling apparatus wherein said commodity is formed by a plurality of individual commodities; said related commodity information transmission means including delivery term presenting means for presenting, responsive to a request from a booking terminal connected over a network, the term of delivery of said individual commodities and the quantity of possible orders under said delivery term, in a confirmable form to said sale store; said order

information acquisition means acquiring from said booking terminal the order information formulated on the basis of the request accepted from a customer to purchase the commodity under the term of delivery presented by said delivery term presenting means; said commodity shipment command means commanding the booked commodity to be shipped to said customer within the term of delivery presented by said delivery term presenting means on the basis of the order information acquired by said order information acquisition means (Figure 3A and Figure 9).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US 6,167,383) in view of Norris et al. (US 7,113,919 B1) (“Norris”) and further in view of Entwistle (US 6,782,551 B1) and Bellini (US 5,974,395).

Henson substantially discloses and teaches the Applicant's invention. Henson does not specially disclose and teach a commodity selling apparatus further comprising: production quantity acquisition means for acquiring the total production quantity per preset period of time of respective commodities, produced in accordance with a production schedule drafted under a preset production schedule sequence; said delivery term presenting means presenting the delivery term as said preset period of time, with an unbooked fraction of the total production quantity during said preset time period as the quantity of possible orders. However, Bellini teaches a commodity selling apparatus further comprising: production quantity acquisition means for acquiring the total production quantity per preset period of time of respective commodities, produced in accordance with a production schedule drafted under a preset production schedule sequence; said delivery term presenting means presenting the delivery term as said

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preset period of time, with an unbooked fraction of the total production quantity during said preset time period as the quantity of possible orders (Abstract; col. 2, lines 55 – 67; col. 3, lines 9 – 15; col. 5, lines 36 – 59; and Figure 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Bellini into the apparatus of Henson. One of ordinary skill in the art would have been motivated to do so in order ensure the timely production and delivery of products.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US 6,167,383) in view of Norris et al. (US 7,113,919 B1) (“Norris”) and further in view of Entwistle (US 6,782,551 B1) and Kennedy (US 6,188,989 B1).

Henson substantially discloses and teaches the Applicant's invention. Henson does not specifically disclose and teach a commodity selling apparatus according further comprising: production quantity acquisition means for acquiring the total production quantity per preset time period for each individual commodity produced in accordance with a production schedule drafted under a preset production schedule sequence; and sale quantity allocation means for deciding an allocation quantity to each sale store corresponding to a fraction of the total production quantity per preset time period as obtained by said production quantity acquisition means; said delivery term presenting means presenting said preset time period as the term of delivery, with an unbooked fraction of said allocation quantity to the sale store which has made said purchase request, as the quantity of possible orders during said preset time period, in a confirmable form to said sale store. However, Kennedy teaches a commodity selling

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apparatus according further comprising: production quantity acquisition means for acquiring the total production quantity per preset time period for each individual commodity produced in accordance with a production schedule drafted under a preset production schedule sequence', and sale quantity allocation means for deciding an allocation quantity to each sale store corresponding to a fraction of the total production quantity per preset time period as obtained by said production quantity acquisition means; said delivery term presenting means presenting said preset time period as the term of delivery, with an unbooked fraction of said allocation quantity to the sale store which has made said purchase request, as the quantity of possible orders during said preset time period, in a confirmable form to said sale store (Abstract, col. 2, lines 37-45; col. 3, lines 35-41; col. 15, lines 38 - 46). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Kennedy into the apparatus of Henson. One of ordinary skill in the art would have been motivated to do so in order ensure the timely production and delivery of products.

Response to Arguments

Applicant's arguments filed 6/5/2005 have been fully considered but they are not persuasive.

Applicant argues that the combination of Henson, Norris, Entwistle, Kennedy and Bellini do not teach "...a quantity of possible orders." Each seller has allocation (promises) available for the various products sold. The examiner disagrees and directs applicant's attention to Kennedy col 7, lines 55 to col 8, line 3 which states that "When a

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customer request comes in to a seller, there may be numerous products that match the request. If the lowest cost product can fully satisfy the request (has sufficient quantity by the requested due date), then the request can simply be promised. Otherwise, a decision may be needed. For example, the customer may be able to choose to have it for a low price but a week later than requested, or by the date requested but 10% higher price. It may be that half the order can be completed on time at the lowest price, but the other half can either be delivered later or for a higher price, and so on. Thus, the ATP can be a list of different products (pricings) with different order lead times, minimum quantities, availabilities dates, and availability quantity”.

Applicant argues that the combination of Henson, Norris, Entwistle, Kennedy and Bellini do not teach “...if one of the related commodities from the proposed order includes functionality that is provided by the commodity.” However, this is a conditional limitation and as such does not move to distinguish the claimed invention from the cited art. This phrase is a conditional limitation with the noted step not necessarily performed. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios. [See: *In re Johnston*, 77 USPQ2d 1788 (CA FC 2006); *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161 (Fed. Cir. 1991); *MPEP* §2106 II C].

Applicant is also directed to col 5 lines 1-5 of Henson for a teaching of a attention instigation mechanism that reports if there is a compatibility (functionality) problem.

Please note that applicant's specification does not contain the terms "inventory" or "functionality". The applicant is asked to locate these terms in the application and define in what context they are being used.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, THIS ACTION IS MADE FINAL even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**.

The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300 [Official communications; including
After Final communications labeled
"Box AF"]

For general questions the receptionist can be reached at

571.272.3600

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Mark Fadok/

Primary Examiner, Art Unit 3625